

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Vinod Chintamani Malshe et al.

Application No.: 10/552,422

Filed: October 7, 2005

Confirmation No.: 6676

For: BIODEGRADABLE ALIPHATIC
POLYESTERS AND
PHARMACEUTICAL COMPOSITIONS
AND APPLICATIONS THEREOF

Art Unit: 1615

Examiner: Caralynne E. Helm

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REQUEST FOR RECONSIDERATION:
PETITION UNDER 37 CFR § 1.181 (a) TO WITHDRAW HOLDING OF
ABANDONMENT

Dear Sir:

On August 26, 2008, the USPTO mailed a Notice of Non-Compliant Amendment to the Attorneys of Record in the matter cited above. However, Applicant's representative never received the Notice of Non-Compliant Amendment. Subsequently, a Notice of Abandonment was mailed on March 17, 2009, citing that Applicants had not timely replied to the Notice mailed on August 26, 2008. Applicants petitioned to withdraw the holding of abandonment because Applicants never received at the address of record the Notice mailed on August 26, 2008. That

petition was dismissed in a decision mailed on July 21, 2009. (See Exhibit A: Petition Dismissal)
This is a timely filed request for reconsideration with respect to that decision.

Applicants are calling upon the requirements of MPEP section 711.03 (c) I A with regard to consideration in this matter. That section states: “an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remain the Office action.” MPEP section 711.01(c) I A. Applicant is requesting that this relief specifically be granted here.

Howard Skaist, undersigned and an attorney with Applicant’s representative called the Petitions Examiner in this case, Karen Creasy, on August 27th, 2009 in an attempt to determine the scope of evidence necessary to successfully have the holding of abandonment withdrawn. Applicant’s representative explained to the Petitions Examiner that the address for the Attorneys of Record in this matter had been changed in 2007 via an Electronic Filing. The Petitions Examiner agreed during the call that such evidence would be compelling in establishing that the steps taken here were reasonable and that this evidence, coupled with evidence that the Notice had not been received, which had already been established in the written record, would go far in terms of obtaining a withdraw of a holding of abandonment.

Applicant’s representative therefore points to Exhibit B, which was received from Else Mebrahtu of the Patent Electronic Business Center of the USPTO. This document establishes that the address for the Attorneys of Record was changed on May 15, 2007. Therefore, Applicant’s representative fully expected to receive USPTO correspondence as this new address.

Now, therefore, Applicant’s representative would like to further clarify the following in support of this petition:

1. On May 15, 2007, Applicant’s representative, Attorneys of Record, changed their mailing address of record with the USPTO via an Electronic Filing. (see Exhibit B: email

- from Patent Electronic Business Center of USPTO) Attorneys of Record in this matter had changed their physical office location on April 7, 2007, as stated in the prior petition.
2. On September 3, 2008, the USPTO received as undelivered a Notice of Non-Compliant Amendment that had been mailed on August 26, 2008 (see Exhibit D: Printout of Notice returned to USPTO, retrieved from Private PAIR record for this matter)
 3. On March 2, 2009, Examiner Caraolynne Helm called the offices of Applicant's representative to determine the status of the present application (see Exhibit C: Affidavit of Tamara Daw).

Here, as set forth above, the Notice of Non-Compliant Amendment mailed on August 26, 2008 was returned to the USPTO as undelivered, as shown by the record on Private PAIR for the present application. Applicant's representative received no communication from the USPTO at its current offices as to the existence of this Notice of Non-Compliant Amendment until March 2, 2009 (after expiration of the six-month statutory period to respond), when Examiner Helm called the offices of Applicant's representative. Applicants, therefore, never received the August 26 Notice of Non-Compliant Amendment in time to respond. Accordingly, Applicants again respectfully request withdrawal of the holding of abandonment of the present application.

Applicants respectfully point out that throughout prosecution of the present application, Applicants have been responsive and diligent in moving the application to allowance. It was only after Applicants did not receive, and were not aware of, a Notice from the USPTO mailed to the old address of Applicant's representative that Applicants failed to respond. Per the requirements of MPEP section 711.03(c) I A, these facts provide a sufficient basis for a withdraw of a holding of abandonment.

That section of the MPEP requires the following (portions from MPEP in italics below):

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should

establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

I, Howard Skaist, Reg. No. 36,008, hereby state for the record that the offices of Berkeley Law & Technology Group, LLP, Attorneys of Record, employ the Prolaw® docketing system, available from Elite®, a Thomson Reuters business, which is used by multiple corporations and law firms to perform the docketing of patent matters. Its acceptance in the marketplace and its use by many entities beyond the Attorneys of Record in this matter demonstrates that it is a sufficiently reliable docketing system. A further factor here is that the Notice in this case was one of Non-compliance, which is not capable of being docketed until after being received by First Class Mail. The matter involved is US Patent Application Serial No. 10/552,422, attorney docket number 044.P001, the mailing date of the Notice at issue was August 26, 2008 and it was due on September 26, 2008.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

The Office action at issue was never received at the offices of the Attorneys of Record. In addition to the evidence submitted as Exhibit D, a search was made of the offices of the Attorneys of Record and all docketing personnel were questioned. Based on these facts, Applicant's representative believes that the Notice was not lost, but, rather, was never received. A copy of the docket for this matter is included as Exhibit E.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the

practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Exhibit E contains a copy of the entire docket in this matter.

In the dismissal of the prior petition, the Petitions Examiner stated: “the evidence submitted is not convincing to substantiate the grants of a petition to withdraw the holding of abandonment in the above application.” Applicants submit that this has now been cured and sufficient evidence has now been submitted.

Likewise, the Petitions Examiner stated in the dismissal of the prior petition that the Attorneys of Record could have called the USPTO to inquire of the status of the change of address. Applicant’s representative would like to make clear that many calls were made to the USPTO in order to clarify this situation after March 2, 2008; however, the fact of those calls was not specifically mentioned in the previous petition. Therefore, Applicant’s representative has been extremely diligent in trying to clear up this matter. Furthermore, while the physical address of the attorneys of record was changed, their phone number was not changed. Therefore, an earlier call to the Attorneys of Record from the Examiner would have resulted in a timely response to the Notice. However, by the time the Examiner handling the Office action had called, the statutory period of six months to respond was already passed. Therefore, even if Applicant’s representative had responded on March 2, 2008, once made aware of the Notice by the phone call from Examiner Helm, that still would not have been sufficient to avoid a holding abandonment without the USPTO resetting the period for response, as is being requested here.

In summary, Applicant’s representative changed its address of record with the USPTO on May 15, 2007; however, because the Notice went to the wrong address and was returned, Applicant’s representative never received it. In addition, as an extra step, Applicant’s representative also subsequently changed their address of record in this specific matter as Private PAIR indicates. Therefore, again, Applicant’s representative has been extremely

diligent in trying to clear this issue. MPEP section 711.03(c) suggests that in circumstances such as these, the holding of abandonment should be withdrawn and the period for response reset. Furthermore, a reply to the Notice also accompanies this request for reconsideration. Favorable action in this regard is respectfully solicited. Any fees or extensions of time believed to be due in connection with this petition are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3130.

Respectfully submitted,
Attorney for Applicant

Dated: /09/21/09/

/Howard A. Skaist/

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